UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

1.   Applicant's arguments filed 4/7/08 have been fully considered but they are not

persuasive. Due to the nature of after-final practice, arguments have been truncated. Further

details will be given in response to an RCE or Appeal Brief.

2.   In response to applicant's argument that all cited references (Afergan, Yoshida, Bannister,

Mizuno and Clarke) are nonanalogous art (P. 4), it has been held that a prior art reference must

either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the

particular problem with which the applicant was concerned, in order to be relied upon as a basis

for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed.

Cir. 1992). In this case, there is a dispute as to how to perform the action.

3.   While it is true that courts may consider the specification and claims in determining the

field of applicant's endeavor, to the extent explained in *In re Wood* (cited in remarks), the cited

case in no way is meant to be construed such that the applicant may so narrowly define the field

of endeavor and particular problem by using a simple statement in the specification. Applicant

improperly narrows the field of endeavor and particular problem to not only require both email

and restricted networks, but to further improperly narrow the field of restricted networks

(remarks P. 5, further narrowed by P. 6). That a piece of art lacks email, restricted networks, a

particular request origin, the disabling of standard mechanisms, requiring manual intervention,

etc. - these may be issues of an improper art rejection but they are not prima facie showings of

non-analogous art. For further analysis, see: *In re Bigio*, 72 USPQ2d 1209 (Fed. Cir. 2004),

KSR International Co. v. Teleflex, Inc., 82 USPQ2d 1385 (U.S. 2007), *Leapfrog Enterprises Inc.*

v. Fisher-Price Inc., 82 USPQ2d 1687 (Fed. Cir. 2007), *Daiichi Pharmaceutical Co. v. Apotex*

Inc., 83 USPQ2d 1471 (D.N.J. 2006), and *In re ICON Health and Fitness Inc.*, 83 USPQ2d 1746

(Fed. Cir. 2007). Further explanation of these cases will be given in response to an Appeal Brief.

4.   Applicant's arguments also fail as a policy matter. By their arguments, an applicant may

construe the field of endeavor and particular problem so narrowly that no 103 rejection could

properly stand. Applicant also performs improper piecemeal considerations when determining

analogous art, and thus fails to consider what a person having ordinary skill in the art might

know in regards to prior art. To accept this argument would, at the very least, change the current

legislation of how to determine obviousness in a non-legislative forum.

5.   The examiner defines the scope of analogous art as being either the retrieval of email

regardless of security *OR* the performance of network security (as regards LANs, proxies and

firewalls) regardless of the type of information retrieved. Every prior art cited fits this field.

Every prior art cited would be known by a person of ordinary skill in the art as an area of

research. Therefore, applicant's allegation of analogous art based on an improper interpretation

of the statute fails.

6.   Regarding the art rejections, applicant takes the examiner to task for not expressly

mapping out the claims (remarks, P. 7). While the examiner has the option of mapping the

claims, they are not necessary when the art may be easily understood and the claims easily

grouped. It is presumed that the applicant will study the art regardless of whether the claims are

mapped. Nevertheless, the examiner will map the sole independent claim here, in order to

alleviate the applicant's confusion. The applicant will note, however, that there is no change in how the art is applied.

7.   In response to applicant's argument that Afergan and Yoshida cannot be applied, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

8.   In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

9.   Ergo, it is not necessary that every piece of art shows both email messages and restricted networks. A person of ordinary skill in the art would have both the ability and the motivation to add email art, regardless of security, to a secure content network. It is not necessary to have a primary art that discloses both the email and the security.

10.   Applicant argues that Afergan does not expressly disclose periodic checking of a restricted communications network by an external unit in a separate network (that may or may not itself be restricted). In doing so, the applicant seems to be confusing areas on restricted network with areas of shielded or protected networks (remarks, Pp. 7-8). When a proxy or firewall shields an origin server, as in Afergan, it forms a restricted communications network - a

LAN of origin content servers – with the proxy shield remaining outside the restricted network to

take the brunt of the attacks (Figs. 3-5; Paras. 25-30). It is the proxy that checks whether to

receive information from the origin server, and to request it when needed, either by passing

along an end user request or by periodically updating internal data for efficiency purposes (Paras.

20-24). As for applicant's claim that Afergan teaches that user requests "simply go out with out

constraint," Afergan teaches not only a requesting mechanism 104 (Para. 21) but that the whole

purpose of the shielding is to constrain user requests from attackers (Paras 28-29).

11.   This leaves the fact that Afergan defines content very broadly (Para. 21), allowing one of

ordinary skill in the art to look at all kinds of protected data and applications, including e-mail

content data and applications. In fact, Afergan specifically states that one of the origin servers is

a mail server (Para. 28). But even if it did not, one cannot conduct piecemeal prosecution but

must focus on what is apparent to one of ordinary skill in the art. In this case, Yoshida teaches a

proxy-firewall method to form a restricted network, the network including a mail server. As

such, the limitations are indeed met by the combination.

12.   In response to applicant's argument that there is no suggestion to combine the references,

the examiner recognizes that obviousness can only be established by combining or modifying the

teachings of the prior art to produce the claimed invention where there is some teaching,

suggestion, or motivation to do so found either in the references themselves or in the knowledge

generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, Yoshida provides a similar structure to Afergan, but with improvements to

communications between end users and proxies on one hand, and backend infrastructure web

servers on the other. For example, Yoshida teaches how to make Afergan more efficient, a motivation behind Afergan's original invention.

13.   Therefore, the rejections are maintained for the reasons above.

Claim Rejections - 35 USC § 103

14.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 1-6, 8, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan et al. (2004/0010601) in view of Yoshida (2004/0049546).

10.   Afergan teaches a method and system (abstract) of sending communications from a data structure in a restricted network (Paras. 1-20), and receiving communications by an external communications unit the communications (Paras. 21-24), the receiver being an intermediary (Paras. 25-26), the data structure including a mail server (Para. 28). In this way, only the external communications network may receive communications from the restricted network (Paras. 27-30), and only via the available port (Paras. 31-39).

11.   Afergan does not expressly disclose the checking to see if mail should be delivered, whether by the external communications network or by the internal restricted network program. Yoshida teaches a method and system (abstract) of mail delivery (Paras. 1-23) to an intermediary from a server on a restricted network (Paras. 24-26) that comprise the missing limitations (Paras. 27-51). At the time the invention was made, one of ordinary skill in the art would have added Yoshida's system to flesh out Afergan's mail server functionality and to reduce Afergan's mail server loads (Para. 5).

12.   For claim 1, Afergan teaches a method (abstract) of facilitating the sending of mail from a restricted communications network (Paras. 1-20), said network comprising:

   a.   Automatically checking periodically (Paras 20-24) by a communications unit external (Fig. 4A, #406-410) to a restricted (Paras. 27-30) communications network (Paras. 3-5, with emphasis on Fig. 4A, #400-404) for a trigger indicating whether backend servers (Para. 28) have changed such that a retrieval should occur (Paras. 23-24);

   b.   Retrieving by the communications unit the mail (Para. 28) from the restricted communications network, in response to the trigger signifying change (Paras. 21-24).

13.   Afergan does not expressly disclose that the trigger signifies whether mail of the restricted communications network is to be sent. Yoshida teaches a method and system (abstract) of mail delivery (Paras. 1-23) to an intermediary from a server on a restricted network (Paras. 24-26) that comprise the missing limitations (Paras. 27-51). At the time the invention was made, one of ordinary skill in the art would have added Yoshida's system to flesh out Afergan's mail server functionality and to reduce Afergan's mail server loads (Para. 5).

14.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and

Yoshida as applied to claims 1, 4, and 6 above, and further in view of Banister et al. (7,219,131).

15.   Afergan and Yoshida do not expressly disclose using a queue program to receive mail

from another program. Yoshida teaches a method and system (abstract) of determining e-mails

for appropriate delivery (col. 1, line 1 – col. 5, line 65; col. 20, line 33 – col. 28, line 25) that

includes delivery decision making procedures (col. 5, line 65 – col. 20, line 33), and includes the

queuing procedure (col. 10, line 50 – col. 12, line 40). At the time the invention was made, one

of ordinary skill in the art would have added these features in order to protect from the security

problem known as spam (col. 2, line 50 – col. 3, line 5).

16.   Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and

Yoshida as applied to claims 1, 8 above, and further in view of Mizuno et al. (2006/0031927).

17.   Afergan and Yoshida do not expressly disclose that the receiver is an intended recipient.

Mizuno teaches a method and system (abstract) of transferring communications data (Paras. 1-

25) from a restricted network to an external server (Paras. 26-30) that includes this limitation

(Paras. 31-34). At the time the invention was made, one of ordinary skill in the art would have

added Mizuno in order to improve seamless access to files behind an Afergan firewall (Paras. 13-

14).

18.   Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Afergan and

Yoshida as applied to claims 1, 8, 11 above, and further in view of Clarke et al. (7,043,240).

19.   Afergan and Yoshida do not expressly disclose that the manner in which a message is

sent to a receiver is dependent on the type of receiver. Clarke teaches a method and system

(abstract) of providing the messages (col. 1, line 1 – col. 3, line 55) that comprise the limitations

(col. 3, line 55 – col. 7, line 30). At the time the invention was made, one of ordinary skill in the

art would have combined the inventions in order to handle a variety of protocols (col. 1, lines 15-

55).

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to MELVIN H. POLLACK whose telephone number is (571)272-

3887. The examiner can normally be reached on 8:00-4:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Jason Cardone can be reached on (571) 272-3933. The fax phone number for the

organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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/M. H. P./

Examiner, Art Unit 2145
28 April 2008